



Docket No. 12969

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Bitler

Serial No.: 09/398,377

Filing Date: 09/17/99

Title: Polymeric Thickeners for Oil-Containing Compositions

Group Art Unit: 1714

Examiner: Szekely

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JUN 25 2003  
TC 1700

Assistant Commissioner for Patents  
Washington, DC 20231

Attention Petitions Branch

**PETITION**

Sir,

This Petition is being filed contemporaneously with a very similar petition on the closely related CIP application Serial No. 09/810, 920. It is believed that the Commissioner will find it convenient to consider both petitions at the same time.

This is a petition asking the Commissioner to direct the Examiner as to the correct construction of certain claims. The Examiner is currently examining these claims on the basis of a construction of the claims which Applicant believes to be wrong. The claims in question have been rejected, and it seems likely that their patentability will be the subject of an appeal. Applicant believes that it is important that further examination, and any appeal, should be based on an agreed construction of the claims.

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**CERTIFICATE OF MAILING UNDER 37 CFR 1.8**

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On June 17, 2003

Typed name of person signing this certificate: T. H. P. Richardson

Signature

## The Claims

The invention relates to the use of certain side chain crystalline (SCC) polymers as thickening agents for oil-containing compositions. The claims in question are independent claims 40 and 45, which are set out below (with emphasis added). These claims are directed to compositions containing an oil and the thickening agent "in amount such that it thickens the oil". The Examiner is examining these claims on the basis that this phrase means (and that the claims are therefore limited to) compositions containing 0.1 to 12% by weight of the SCC polymer.

The application includes claims which are dependent on independent claims 40 and 45 and which have also been rejected. The application also includes other independent claims, and claims dependent thereon, which have been allowed and as to which there is no dispute.

40. *A thickened oil cosmetic composition which comprises*

- (1) *an oil, and*
  - (2) *dispersed in the oil, a polymer which*
    - (a) *has a crystalline melting point,  $T_p$ , and an onset of melting temperature,  $T_o$ , such that  $T_p - T_o$  is less than  $T_p^{0.7}$ ;*
    - (b) *is soluble in the oil at temperatures above  $T_p$ ,*
    - (c) *has been dispersed in the oil by a process which comprises*
      - (i) *dissolving the polymer in the oil at a temperature above  $T_p$ , and*
      - (ii) *cooling the solution to crystallize the polymer in the oil,*
    - (d) *is a side chain crystalline (SCC) homopolymer which is substantially free of functional groups, and*
    - (e) ***is present in amount such that it thickens the oil;***
- the composition being at a temperature*

- (i) which is below  $T_p$ , and
- (ii) at which the composition, in the absence of the polymer, is liquid.

45. A thickened oil cosmetic composition comprising

(1) an oil, and

(2) dispersed in the oil, a polymer which

(a) has a crystalline melting point,  $T_p$ , and an onset of melting temperature,  $T_o$ , such that  $T_p - T_o$  is less than  $T_p^{0.7}$ ;

(b) is soluble in the oil at temperatures above  $T_p$ ,

(c) has been dispersed in the oil by a process which comprises

(i) dissolving the polymer in the oil at a temperature above  $T_p$ , and

(ii) cooling the solution to crystallize the polymer in the oil,

(d) is a side chain crystalline (SCC) polymer which is substantially free of functional groups, and which consists of

(i) 50 to 100% by weight of units derived from at least one *n*-alkyl acrylate or methacrylate in which the *n*-alkyl group contains 12 to 50 carbon atoms, and

(ii) 0 to 50% by weight of units derived from at least one alkyl acrylate or methacrylate in which the alkyl group is not an *n*-alkyl group containing 12 to 50 carbon atoms, and

(e) **is present in amount such that it thickens the oil;**

the composition being at a temperature

(i) which is below  $T_p$ , and

(ii) at which the composition, in the absence of the polymer, is liquid.

## The Issue

The issue is the meaning of the phrase "is present in amount such that it thickens the oil".

## The Relevant Facts

1. The Disclosure of the Specification as filed.

The specification as filed does not state explicitly that the thickening agent "is present in amount such that it thickens the oil". It does, however, contain numerous statements and specific Examples which make it clear that the purpose and result of adding the crystalline polymer thickening agent is to thicken the oil. The following passages are quoted by way of example.

*Polymeric Thickeners for Oil-Containing Compositions (title)*

*It is known to use polymers to thicken oil-containing compositions.*

*Reference may be made for example to U.S. Patent No. 5, 318,995 (Mondet et al.) and U.S. Patent No. 5, 736,125 (Morawsky et al.) the disclosure of each of which is incorporated herein by reference for all purposes. (Page 1, lines 10-13)*

*I have discovered, in accordance with the present invention, that oil-containing compositions can be thickened with polymers which contain long chain alkyl groups in side chains but which contain no, or relatively few, acid groups as specified in U.S. Patent No. 5,736,125 or acid salt groups as specified in U.S. Patent No. 5,318 995. Furthermore I have been able to obtain improved results through the use of such polymers. The polymers which are useful in the present invention are crystalline polymers, preferably side chain crystalline (SCC) polymers which...*

*the use of such polymers as thickening agents (page 3, lines 18-19),*

*the polymers used as thickeners in the present invention (page 5, line 15),*

*the thickening polymer (page 8, lines 23 and 30),*

*the polymeric thickener (page 5, line 13, page 9, lines 12, 18 and 25),*

*The amount of the polymeric thickener preferably used varies with the application. It is usually unnecessary to use more than 10% of the total composition, and smaller amounts such as 3 to 7%, for example about 5%, are often effective. (Page 9, lines 12-14)*  
*a thickened oil composition (Claim 1, line 1).*

2. After the claims had been rejected under 35 U.S.C. 102 and 103 over U.S. Patent No. 5,281,329 ("Mueller"), Applicant limited the claims to require that the thickening agent "is present in amount such that it thickens the oil", and argued that this limitation distinguished the claims from the Mueller reference.

3. The Examiner rejected the amended claims under 35 U.S.C. 112 for lack of written description on the ground that the added limitation involved new subject matter, and for lack of enablement.

4. In the Reply mailed July 31, 2002, and the Supplemental Reply mailed Oct. 17, 2002, Applicant traversed the rejection under 35 U.S.C. 112, arguing that no new subject matter was involved and that the claims were enabled, referring to the passages in the specification quoted above, and noting that the specification provides specific examples of thickened oils.

5. The Office Action mailed November 25, 2002, withdrew the rejection under 35 U.S.C. 112, and stated:

*The Examiner acknowledges that Morawsky... incorporated by reference, does contain the phrase "present in the amount sufficient to thicken the composition" in column 3, lines 19-24, so that limitation is not new matter. Since (Morawsky) defines that amount as 0.1-12% by weight, the phrase will be interpreted as such.*

6. The disclosure of Morawsky.

Morawsky, which is also summarized on page 1, lines 15-24, of the specification as filed, discloses that certain specifically defined carboxyl-containing SCC polymers can be used to thicken oils. The following passages are quoted from Morawsky.

*In the compositions, the amount of thickening copolymer, as defined above, is present in an amount sufficient to thicken the composition to the desired thickness. In general it is present in an amount of from about 0.1% to about 12%, particularly from about 0.5 to about 10% by weight of the oil.... The composition may be thickened to the desired viscosity which is dependent on the functional properties of composition. (Column 3, lines 19-33).*

1. *A composition comprising an oil and a polymeric thickener consisting essentially of at least one copolymer which has a hydrophobic functionality sufficient to provide at least partial solubility in oil and a hydrophobic functionality present in an amount effective to provide thickening of the oil, said hydrophobic functionality being... (Claim 1).*

6. *The composition of Claim 1, wherein the copolymer is present in an amount ranging from about 0.1 to about 12% by weight of the oil. (Claim 6).*

7. In the Reply mailed January 27, 2003, Applicant argued, referring to the passages quoted in paragraph 6 above, that neither the claims nor Morawsky should be interpreted to have the limited meaning adopted by the Examiner; and asked the Examiner to state on the record that further examination would be carried out on the basis that the phrase mean simply what it says and is not limited to amounts in the range 0.1 to 12 %.

8. The Office Action mailed March 31, 2003, does not state whether the continued rejection of the claims was based on the Examiner's limited construction.

9. In a telephone interview with the undersigned on June 12, 2003, the Examiner made statements which, insofar as they could be understood by the undersigned, indicated that the Examiner was continuing examination on the basis of the limited construction of the claims.

10. In the Reply mailed contemporaneously with this Petition, Applicant asked the Examiner once again to consider the proper construction of the claims, and either

- (i) to state on the record his agreement that the claims in question cover the use of any amount of thickening agent which will in fact thicken the oil, i.e. the use of amounts which may be outside the range of 0.1 to 12%, or
- (ii) to send this Petition to the Petitions Branch so that the issue could be resolved.

11. The Reply mailed contemporaneously with this Petition also requests amendments which result in the following claims 42 and 50 which are dependent on claims 40 and 45 respectively, and which specify that the thickening agent is present in amount 0.1 to 12% by weight.

*42. A composition according to Claim 40 wherein the SCC polymer is present in amount 0.1 to 12% by weight.*

*50. A composition according to Claim 45 wherein the SCC polymer is present in amount 0.1 to 12% by weight.*

The specification as filed does not state explicitly that the thickening agent can be present in amount 0.1 to 12%. The basis for these claims is in above-quoted passages of Morawsky U.S. Patent No. 5,736,125, which is incorporated by reference. Applicant's purpose in adding these claims is to provide further evidence, through the doctrine of claim differentiation, that claims 40 and 45 cover amounts of the SCC polymer outside the range of 0.1 to 12%.

## Argument

For the reasons set out below, Applicant believes that the claims 40 and 45 should not be examined on the basis of the limited construction adopted by the Examiner, but rather on the basis that the claims cover the use of any amount of thickening agent which will in fact thicken the oil, i.e. the use of amounts which may be outside the range of 0.1 to 12%.

A. The passages quoted in paragraph 1 above from the specification as filed make it clear that Applicant's invention is directed broadly to the use of the defined SCC polymers as thickening agents for oil-containing compositions, and is not limited to any specific numerical range of concentration. The disclosure of the specification itself is reinforced by the facts and arguments set out in

(i) the Reply mailed July 31, 2002, and the Supplemental Reply mailed Oct. 17, 2002, and

(ii) the Reply mailed January 27, 2002, on the CIP application Serial No. 09/810,190,

to which reference should be made.

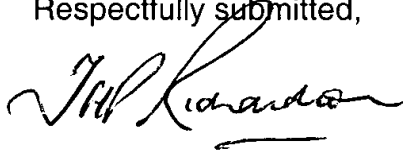
B. The passages quoted in paragraph 6 above from Morawsky make it clear that Morawsky's invention is directed broadly to the use of the defined carboxyl-containing SCC polymers as thickening agents for oil-containing compositions, and is not limited to the use of 0.1 to 12% of the SCC polymer. The quoted passage from column 3, lines 19-33, states simply that the SCC polymer is used "in an amount sufficient to thicken the composition, and then goes on to state that "in general" (i.e. **not** invariably) the amount is from "about 0.1% to about 12%". Claim 1 similarly refers to "an amount effective to provide thickening of the oil", and the presence of Claim 6, specifying that the amount is 0.1 to 12% and not otherwise limiting Claim 1, puts it beyond doubt (having regard to the requirement of 35 U.S.C. 112, fourth paragraph, that a dependent claim must "specify a further limitation of the subject matter claimed) that the amount referred to in Claim 1 is not limited to the range of 0.1 to 12%.



C. The presence of amended claims 42 and 50 makes it clear (again having regard to 35 U.S.C. 112, fourth paragraph) that claims 40 and 45 are not limited to the range of 0.1 to 12%.

D. MPEP 2111 requires that during Patent examination, the pending claims must be "given the broadest reasonable interpretation consistent with the specification".

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'T. H. P. Richardson', with a horizontal line underneath.

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